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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/622,850	12/14/2000	Jose Raul San Miguel Gomez	JG-GV-4999 /5	8133

26418 7590 05/03/2004

REED SMITH, LLP  
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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 05/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/622,850

Applicant(s)

SAN MIGUEL GOMEZ ET AL.

Examiner

Mitra Aryanpour

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2003 & 02 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made with regards to Applicants' remarks that applicants' are in the process of obtaining a certified copy of the foreign application. However, as applicants' may be aware the claim to foreign priority cannot be granted until a certified copy of the Spanish application as required by 35 U.S.C. 119(b) has been received.

### ***Drawings***

2. Applicant has overcome the previous objection to the drawings. However, the drawings in this application are objected to as informal. Formal drawings will be required upon allowance of the case. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

### ***Specification***

3. The substitute specification submitted on 02 March 2004 has been entered.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed

Art Unit: 3711

invention. the newly added limitation “a patient” in claims 1 and 7, is considered as new matter, since a disabled or wheelchair-bound person is not necessarily a patient.

The 112 2<sup>nd</sup> rejections have been overcome by the amendments to claims.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-3 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Saderne (FR 719,778).

Regarding claim 1, Saderne discloses an apparatus characterized by the fact that it is composed of a body (1) that reproduces the shape and size of a human foot fairly faithfully, up to the top of the foot (see figures 1-5), while from the top of the body (1) a short arm (15 or in the alternative 14) emerges, this ending in a handle (centralized section 16) arranged noticeably parallel to the axis of the body (1), in such away that a person can handle and manipulate the apparatus with the movement of the wrist. Note: The preamble, “an apparatus for playing soccer in a wheelchair”, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness.

Regarding claim 2, Saderne shows the base (not identified by a reference number, but clearly seen in all the figures) of body (1) is symmetrically representing an imaginary

Art Unit: 3711

longitudinal, vertical and middle plane, while both sides are concavely curved (best see in figure 2).

Regarding claim 3, Saderne shows the structure to be composed of a multiplicity of parts conveniently assembled together.

Regarding claim 5, note the rejection of claim 3.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saderne (FR 719,778) in view of Cumbie (5,040,813).

Regarding claims 4 and 6, Saderne is silent with regards to providing a support in the form of a holder for the apparatus. Cumbie shows an accessory holder that is used as a mount for attachment to wheelchairs (see figures 5-12, column 3, lines 61-68 and column 4, lines 1-62). Cumbie's accessory holder can be formed in any shape and size and it is suitable for affixing to any suitable point on a wheelchair (see figures 5-11). The accessory holder allows for a variety of different objects to be temporarily held in place in order to allow the upper limbs of the user to be free during the movement of the wheelchair (see figure 1). In view of Cumbie, it would have been obvious to provide a holder that is attachable to a wheelchair for holding and carrying the apparatus of Saderne, the motivation being to aid a wheelchair-bound person to transport objects in a wheelchair.

***Allowable Subject Matter***

10. Claim 7 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action.

***Response to Arguments***

11. Applicants' arguments filed 02 March 2004 have been fully considered but they are not persuasive. In response to applicant's argument regarding the intended use, a recitation of the intended use of the claimed invention, in the instant case playing soccer in a wheelchair must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the claimed apparatus is for use by a person in a wheelchair to play a game of soccer. The above recitation merely suggests that the person in the wheelchair can use an apparatus such as the one being claimed to play soccer. Saderne's apparatus meets the structural limitation of the claimed invention; therefore, it is capable of being utilized as the claimed apparatus for use in a soccer game. With regards to applicants' remarks that there is no reference, that reference character 16 can be used as a handle. The combination of the vertical threads or legs (14 and 15), the horizontal section (14a and 15a) and the central section 16 form a handle (see figure 1) which allow for 1) insertion of the shoetree into and out of a shoe and 2) the adjustment of the overall length of the foot portion in order to be properly sized for the shoe. It should be noted that the term "handle" implies no particular structure that is different from

Art Unit: 3711

Saderne's elements (14, 14a, 15 and 15a). These elements are inherently capable of being used as a handle.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the instant case, Cumbie's provides a holder that can be formed in any shape and size and it is suitable for affixing to any suitable point on a wheelchair. Furthermore, the holder can be used for holding a variety of different objects.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3711

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 703-308-3550. The examiner can normally be reached on Monday - Friday 9:00 to 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA  
26 April 2004

  
**MITRA ARYANPOUR**  
**PATENT EXAMINER**